

REMARKS

Amendments to the Claims

Upon entry of the present amendments, claims 26, 28-32, 36 and 37 are pending.

Claim 36 is amended to specify that the retractable tip is retractable to a position fully inside the cap. Support for this amendment is found, *e.g.*, in Figs. 3A and 3B.

New claim 37 specifies that the second end of the elongated body is closed. Support for this amendment likewise is found, *e.g.*, in Figs. 3A and 3B.

Accordingly, the present amendment does not introduce new matter.

Each of the grounds for rejection cited in the Office Action is addressed below, under an appropriate sub-heading.

35 U.S.C. §103(a)

A) Claim 26:

Claim 26 was rejected as being rendered obvious by JP 11-154052A (Shiroyuki) in view of US 5,889,512 (Moller).

Claim 26 specifies, *inter alia*, that the cap has:

a first aperture adapted *to receive* the first end of the elongated body, . . . wherein the second end of the elongated body cooperates with the cap *to extend the non-writing tip outwardly from the second aperture as the cap receives the second end of the elongated body*.

(Emphasis added). Claims 28-32 and 37 depend from claim 26 and, therefore, also incorporate these limitations.

As noted by the Examiner, Shiroyuki fails to disclose a retractable tip, wherein cooperation between the elongated body and the cap extends the tip outwardly from the second aperture as the cap receives the elongated body. Nevertheless, Moller is cited as a source for this missing limitation, and the conclusion was reached in the Office action that “it would have been obvious to the one of ordinary skill in the art to use the teaching of the retractable tip of Moller into the cap of Shiroyuki since it is well-known in the art that most of the pen or fountain pen

having retractable tip, which can be movable inside the body of the pen for protection of the pen when not in use.”

This conclusion begs the question of how one could incorporate the teaching from the stylus of Moller into the pen of Shiroyuki and what motivation or suggestion there would be for doing so. The Examiner equated the rear portion (18) of the stylus body (12) in Moller with the cap of Applicants’ Claim 1. This rear portion (18) in Moller can be most closely compared with the end part (18) of the writing implement (15 and 22) in Shiroyuki. The end part (18) of the writing implement (15 and 22) in Shiroyuki, however, is closed (*i.e.*, sealed off), in contrast with the rear portion (18) in the stylus body (12) of Moller, which is open. The rear portion (18) of Moller is open in the sense that it includes an orifice through which the extension member (48) extends to couple the extension cap (60), which is outside the stylus body, with a spring (52) contained inside the stylus body. Because the end part (18) in Shiroyuki is closed, the extension member (48) of Moller could not pass through the closed end of Shiroyuki’s writing implement (15 and 22); and the structures are therefore incompatible for the proposed substitution.

Moreover, contrary to the Examiner’s characterization of Moller (in reference to claim 36), the screw end (42) of the rear portion (18) is not designed for positioning **over** the threaded bore (38) of the grip portion (16) of Moller’s stylus; rather, the screw end (42) fits **inside** the bore (38). Consequently, the grip portion (16) of Moller **receives** the rear portion (18) rather than *vice versa*. The cap of claim 1, which is adapted **to receive** the elongated body, is accordingly further distinguished from the rear portion (18) of Moller.

In Shiroyuki, a nib (11) for entering data into a PDA is provided on a cap (P1 and P2) that is separate and distinct from the writing implement (15 and 22). Instead, the cap (P1 and P2) in Shiroyuki is a readily removable component that slides over the closed end part (18) of the writing implement (15 and 22). The closed-ended structure of Shiroyuki’s writing implement (15 and 22) precludes access to internal components for manipulation via the extension member (48) of Moller. Consequently, the motivation in Moller for including the displaceable extension member and extension cap (to provide external access for activation of a spring inside a stylus body) is not pertinent to the apparatus of Shiroyuki. Moreover, no other motivation is provided in Moller or Shiroyuki for providing, in the cap of Shiroyuki, a structure that cooperates with the

elongated body to extend the non-writing tip outwardly from the second aperture as the cap receives the second end of the elongated body, as specified in Applicants Claim 1.

As specified in *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000), “a showing of a suggestion, teaching, or motivation to combine the prior art references is an `essential component of an obviousness holding.’” If this rejection is to be maintained, Applicants respectfully solicit an articulation of (a) how the extension cap and extension member from the stylus of Moller could be incorporated into the cap of the pen of Shiroyuki and (b) a specific identification of the motivation in Moller or Shiroyuki that would lead one skilled in the art to incorporate such a structure into the cap for the pen of Shiroyuki, since the cap of Shiroyuki serves a different purpose than does the rear portion of the stylus body of Moller.

Absent such a showing and because the designs of Moller and Shiroyuki are otherwise incompatible for the suggested substitution and further because there is no teaching, suggestion or motivation in Moller or Shiroyuki for incorporating the cooperative design between the cap and elongated body defined in claim 1 into the cap of Shiroyuki, Applicants respectfully request that this rejection be reconsidered and withdrawn.

B) Claim 36:

Claim 36, the other independent claim, was rejected as being obvious in view of Moller. Claim 36 is amended, herein, to specify that the retractable tip is moveable to a first normal position retracted fully inside the cap.

The extension member (48) and extension cap (60) of Moller, which the Examiner equated with the retractable tip of claim 36, cannot be retracted fully inside the rear portion (18) because the cap (60) has a diameter greater than that of the bore extending through the rear portion (18), as is particularly evident in Figs. 13 and 14 of Moller, nor is there any motivation in Moller for modifying its structure so as to make the cap fully retractable inside the rear portion (18).

Absent any teaching, suggestion or motivation in Moller (or in any of the other recited references) for designing a cap into which a retractable non-writing tip can be fully retracted, Applicants respectfully request that this rejection be reconsidered and withdrawn.

CONCLUSION

On the basis of the foregoing remarks and amendments, Applicants respectfully submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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